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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			GILLIGAN, CHRISTOPHER L	
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/706,101	HAYES, FRANCIS E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 15 November 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-3,5-8,10 and 12-35 is/are pending in the application.
- 4a) Of the above claim(s) 29-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-8,10,12-28,33 and 35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

***Response to Amendment***

1. In the amendments filed 10/16/06 and 11/15/06, the following has occurred: claims 1, 12, 13, 15, and 16 have been amended, claim 11 has been canceled, and claim 35 has been added. Now, claims 1-3, 5-8, 10, 12-28, 33, and 34 are presented for examination and claims 29-32 are withdrawn.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2-3, 5, 12-14, 19-28, and 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the phrase "optionally including the complete sentence...corresponding to the one of the plurality of insured parties" in step (g). It is unclear whether the step following the term "optionally" is required or whether the step is intended to merely be recited in the alternative (i.e. performing the step or not performing the step). Also, it is unclear what the option is based on. It should be noted that if the option to included is only based on a subjective decision by a user of the system, the claim may be unstatutory for failing to provide a concrete (i.e. repeatable) result. For Examination purposes, the Examiner will treat the limitation as being recited in the alternative.

5. Claims 2-3, 5, 12-14, 19-28, and 33-34 are rejected for the same reasons as claim 1 through dependency.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 6, 7, 19, 21-23, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745, <http://www.acords.com> (Pages generated through <http://www.archive.org> dated no later than 02/03/1999, pages numbered by Examiner, hereinafter referred to as Choices), and Leming, Chubb lets shippers review, download certificates online (hereinafter Leming, paragraphs numbered by Examiner) and further in view of Grow, U.S. Patent No. 6,694,315.

8. As per claim 1, Scheinuk teaches a system for generating a certificate of insurance, relative to an insured party, for a third party-requester who is not the insured party or an insurer or an insurance producer, relative to the insured party, comprising: a database storing insurance coverage information about each of a plurality of insured parties (see paragraph 0009); and a computer system communicably coupled to the database, the computer system including computer program instructions to: a) provide a first user interface to accept, from a first user, an identification of one of the plurality of insured parties and information identifying a third party who is to be authorized to receive a certificate of insurance, relative to the one of the plurality of insured parties (see paragraphs 0044-0045); b) determine if the first user is authorized to enter information into the database (see paragraph 0079); c) if the first user is authorized, store information about the third-party the database in association with the one of the plurality of insured parties (see paragraph 0089). Scheinuk further teaches an interface to accept identification of a third-party requester from an insurance agent or insurer, and providing the

third-party requester with a certificate of insurance (see paragraph 0045). Scheinuk further teaches the second user interface is operative to accept proposed text to be entered into the generated certificate of insurance and enter a complete sentence into the generated certificate of insurance such that the complete sentence is not modifiable by the second user (see paragraph 0062).

9. Scheinuk does not explicitly teach the recited functions d) – f). However, Choices describes a system for generating certificates of insurance that includes the functions of: providing a user interface to accept user credentials and an identification of one of the plurality of insured parties from a third-party requester, wherein the second user interface is accessible by at least a user who is not the one of the plurality of insured parties or an insurance producer or an insurer, relative to the one of the plurality of insured parties (see page 2, in particular, “Certs OnCall” enables a third-party requester to identify themselves as well as an insured through the use of a supplied password); determine if the third-party requester is authorized to generate a certificate of insurance, relative to the one of the plurality of insured parties, comprising determining if the user credentials accepted from the third-party requester by the second user interface correspond to the information about the third-party stored in association with one of the plurality of insured parties (see pages 2 and 4); and if the third-party requester is authorized, generate a certificate of insurance relating to the one of the plurality of insured parties and provide the generated certificate of insurance to the third-party requester (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this functionality for the purpose of further reducing the burden on insurance agency personal by providing immediate web-based access to certificates to certificate holders (see paragraphs 0006-0007 of Scheinuk).

10. In addition, neither Scheinuk nor Choices explicitly teaches that the second user interface is operative to accept proposed text to be entered into a remarks box within a certificate of insurance and forming a complete sentence reflecting the proposed text and entering the proposed text into the remarks box within a certificate of insurance to be generated such that the complete sentence is not modifiable by the third-party requester.

11. Leming teaches an online certificate of insurance system that includes the feature of allowing various parties to enter free-form text into a certificate of insurance to be generated if access is authorized (see paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the combined system of Scheinuk and Choices. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing the flexibility of adding wording that may be required by relevant parties in certain cases (see paragraph 6).

12. Furthermore, Grow teaches an automated document creation system that includes boxes for entering text to be automatically entered in legal documents (see column 6, lines 23-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of the document creation process within Scheinuk and to provide custom tailored application for different entities within the document creation process (see column 2, lines 1-4 of Grow).

13. As per claim 2, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about a plurality of passwords corresponding to at least one of the plurality of insured parties, each of the passwords being associated with a different subset of the insurance coverage information about the at least one of the plurality of insured parties (see paragraph

0049 and Table 2); and the second user interface is operable to accept a password from the second user and to generate the certificate of insurance such that the generated certificate of insurance contains a subset of the insurance coverage information associated with the entered password (see paragraph 0061). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

14. Claims 6 and 7 recite substantially similar method limitations to those already addressed in system claims 1 and 2 and, as such, are rejected for similar reasons as given above.

15. As per claim 19, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 1 as described above. Scheinuk further teaches the first user interface is operable to accept an identification of at least one type of insurance carried by the one of the plurality of insured parties and to store the at least one type of insurance in the database in association with the one of the plurality of insured parties (see paragraph 0065); the second user interface is operative to: display only the at least one type of insurance corresponding to the one of the plurality of insured parties (see paragraph 0066); allow the second user to select at least one of the displayed at least one type of insurance (see paragraph 0066); and the computer system is operative to generate the certificate of insurance based on the selected at least one type of insurance (see paragraph 0069). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

Art Unit: 3626

16. As per claim 21, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 19 as described above. Scheinuk further teaches the first user interfaces is operative to input an indication that the words "Endeavor to" may be omitted from a cancellation clause in a certificate of insurance associated with the one of the plurality of insured parties and to store the indication in the database in association with the one of the plurality of insured parties (see paragraph 0062); and the computer system is operative, responsive to the association of said indication with said insured party, for preventing removal of the words "Endeavor to" in a cancellation clause of the generated certificate of insurance (see paragraph 0062).

17. As per claim 22, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to present a list of insurance options that includes those listed and to permit the first user to select at least one of the list of insurance options and the computer system is operative to store the selected at least one insurance option in the database in association with the one of the plurality of insured parties (see paragraph 0071); the second user interface is operative, responsive to the selected at least one insurance option to display only the selected at least one insurance option (see paragraph 0066).

18. As per claim 23, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to input revised additional insured wording to be included in the generated certificate of insurance (see paragraph 0071); and the computer system is operative to insert the revised wording into the generated certificate of insurance in response to an indication of an additional insured option by the second user (see paragraph 0071). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

19. As per claim 33, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 2 as described above. Scheinuk further teaches providing a third user interface to accept, from a third user, at least one password and an identification of a subset of the insurance coverage information stored in the database and associated with the third user and to associate the at least one password with the identified subset of the insurance coverage information (see paragraph 0049 and Table 2).

20. As per claim 12, Scheinuk in view of Choices, Leming, and Grow teach the system of claim 11 as described above. Scheinuk further teaches the second user interface is responsive to whether or not any text was entered (see paragraph 0089).

21. As per claim 13, Scheinuk in view of Choices, Leming, and Grow teach the system of claim 11 as described above. Scheinuk does not explicitly teach forming a complete sentence responsive to a selected one of a plurality of items listed within a pull down menu. Grow teaches forming complete sentences responsive to a selected one of a plurality of items listed within a pull down menu (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

22. As per claim 14, Scheinuk in view of Choices, Leming, and Grow teach the system of claim 13 as described above. Scheinuk does not explicitly teach said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with an insurance type. Grow teaches said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with a predetermined event (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

23. Claims 15-18 recite substantially similar method limitations to those already addressed in system claims 1 and 12-14 and, as such, are rejected for similar reasons as given above.

24. Claims 27-28 recite substantially similar additional limitations to those already addressed in claims 11-12 and, as such, are rejected for similar reasons as given above.

25. Claim 35 recites substantially similar additional limitations to those already addressed in claim 1 and, as such is rejected for similar reasons as given above

26. Claims 3, 5, 8, 10, 24-26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above), Leming, Chubb lets shippers review, download certificates online (hereinafter Leming, paragraphs numbered by Examiner) and Grow, U.S. Patent No. 6,694,315 and further in view of Luchs et al., U.S. Patent No. 4,831,526.

27. As per claim 3, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about an approving party corresponding to at least a subset of the insurance coverage information corresponding to at least one of the plurality of insured parties (see paragraph 0049); and the computer system is operative to send an electronic message prior to generating the certificate of insurance, the electronic message including at least a portion of a proposed certificate of insurance and to generate a certificate of insurance (see paragraph 0089). Scheinuk does not explicitly teach only generating a certificate of insurance if an approval response to received from the approving party. Luchs teaches only generating an

insurance document if an approval response is received from an approving party (see column 6, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Scheinuk. On of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of reducing errors in the generation of certificates of insurance by first checking with an approving party (See paragraph 0006 of Scheinuk).

28. As per claim 5, Scheinuk in view of Choices, Leming, Grow and Luchs teaches the system of claim 3 as described above. Scheinuk further teaches the at least a portion of the proposed certificate of insurance included in the electronic message is modifiable by the approving party and the generated certificate of insurance is generated according to modifications made by the approving party (see paragraphs 0089-0090).

29. Claims 8 and 10 recite substantially similar method limitations to those already addressed in system claims 3 and 5 and, as such, are rejected for similar reasons as given above.

30. Claims 24-26 contain substantially similar additional limitations to those already addressed in claims 3 and 5 and, as such, are rejected for similar reasons as given above.

31. Claim 34 recites substantially similar additional limitations to those already addressed in claim 3 and, as such is rejected for similar reasons as given above.

32. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above), Leming, Chubb lets shippers review, download certificates online (hereinafter Leming, paragraphs numbered by Examiner), and Grow, U.S. Patent No. 6,694,315 and further in view of McKee et al., U.S. Patent No. 6,272,482.

33. As per claim 20, Scheinuk in view of Choices, Leming, and Grow teaches the system of claim 19 as described above. Scheinuk further teaches the second user interface is operable to input a requested number of cancellation days (see paragraph 0067). Scheinuk does not explicitly teach inputting a maximum and minimum number of cancellation days for comparison to a requested number of cancellation days and comparing this data to produce the error messages. McKee teaches the use of business rules to establish a maximum and minimum number of cancellation days (see column 4, lines 38-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these rules into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of complying with state laws regarding cancellation (see column 4, lines 61-66 of McKee).

#### ***Response to Arguments***

34. In the remarks filed 10/16/06, Applicants argue in substance that (1) the Choices references does not allow a third party requester to “generate” a certificate as described in Applicant’s specification; (2) there is no motivation to combine the systems of Choices and Scheinuk with Grow.

35. In response to Applicants’ argument (1), it is respectfully submitted that the Examiner has interpreted the displaying and printing of the certificate of insurance, by the third party requestor, to be a form of generating the certificate of insurance as claimed. It appears that Applicants’ are arguing that since the Choices reference does not allow a third party requestor to actually create a previously unformed certificate of insurance (such as through a series of questions and answers), the reference does not teach “generating” a certificate of insurance. However, the Examiner respectfully submits that the specification has not specifically and

deliberately defined this term in such a way as to limit its meaning in the claim. Page 9 of Applicants' specification, as cited in the remarks, describes a series of steps involved in creating a certificate of insurance but does not actually use the term "generate" or any form thereof. Therefore, since these steps are not recited in the claims, they are not given any weight with respect to limiting the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the Examiner has relied upon the teachings of Grow and the newly added Leming reference to teach those limitations that are directed to editing of the certificate of insurance.

36. In response to Applicants' argument (2), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has clearly cited motivation from the teachings of Grow (see above rejections).

### ***Conclusion***

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
39. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3626

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/5/07



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